

W



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,899	11/30/2001	Howard Taub	10982142-1	3258

7590 04/28/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,899

Applicant(s)

TAUB ET AL.

Examiner

James W Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment and response filed on January 10, 2005 is sufficient to overcome the Marks et al (US2001/0034651) reference. The amendment substituted a new abstract and amended the specification and Claims 30, 40, 42, 43, and 45. The currently pending claims considered below are Claims 1-48.

Specification

2. The new abstract filed on January 10, 2005 is acceptable and has been entered in the application. Therefore, the Examiner hereby withdraws the previous objection in the October 12, 2004 Office Action.

3. The changes to the specification filed on January 10, 2005 are acceptable and have been entered in the application.

Claim Rejections - 35 USC § 101

The amendment filed on January 10, 2005 has placed Claims 30-38, 40-43, and 45-48 within the realm of statutory subject matter. Therefore, the Examiner hereby withdraws the previous rejection of those claims under 35 U.S.C. § 101 in the October 12, 2004 Office Action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-12, 30, 35-37, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al (5,794,210)

Claim 1: Goldhaber discloses an apparatus for presenting content packages to a user, comprising:

- a. A processor (col 9, lines 33-40);
- b. A memory with a content package stored thereon (col 10, lines 39-63 and col 15, lines 26-28); and
- c. The content package including a message, a bank id, and a display value (col 10, lines 39-63).

The Examiner notes Claim 1 is directed towards a server with three parts: a processor, a memory, and a content package (i.e. data) stored on the memory. Since no action is being taken on the stored data, no patentable weight is given as to what the data is or what type of data it is. However, notwithstanding that, Goldhaber does disclose a server with the same type of data stored thereon.

Art Unit: 3622

Claim 5: Goldhaber discloses the apparatus of Claim 1 above, and further discloses digitally signing the content package (col 10, lines 9-38 and col 16, lines 50-64).

Claim 6: Goldhaber discloses the apparatus of Claim 1 above, and further discloses instructions for receiving the value (col 11, lines 45-58).

Claims 7-9: Goldhaber discloses the apparatus of Claim 1 above, and further discloses that the value is monetary, a credit on a purchase, or a credit clip (i.e. coupon)(col 11, lines 8-44 and col 18, lines 13-33).

Claim 10: Goldhaber discloses the apparatus in Claim 1 above, and further discloses constructing and delivering the content package (col 9, lines 62-67).

Claims 11 and 12: Goldhaber discloses the apparatus of Claims 1 and 10 above, and further discloses receiving notice of receipt or recall (deletion) of the package (col 5, line 54 – col 6, line 2 and col 17, lines 49-52).

Claim 30: Goldhaber discloses a method for presenting content packages to a user, comprising:

- a. Constructing and delivering a content package (col 9, lines 62-67);

Art Unit: 3622

b. Receiving notification of receipt of the content package (col 5, line 54 – col 6, line 2); and

c. Crediting the value to the receiver (user)(col 16, lines 13-17).

Claim 35: Goldhaber discloses the method as in Claim 30 above, and further discloses the message is an advertisement (col 9, lines 62-67 and col 15, lines 25-27).

Claim 36: Goldhaber discloses the method as in Claim 30 above, and further discloses verifying the bank account id and the funds therein (col 7, lines 48-61).

Claim 37: Goldhaber discloses the method as in Claim 30 above, and further discloses instructions for receiving the value (col 11, lines 45-58).

Claim 39: Goldhaber discloses the method of Claim 30 above, and further discloses digitally signing the content package (col 10, lines 9-38 and col 16, lines 50-64).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 4, 13-29, 32-34, 39, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (5,794,210).

Claims 13, 22, 24, 40, 43, and 45: Goldhaber discloses a method, apparatus, and computer program for presenting content packages to a user, comprising:

- a. Providing a computer processor (col 9, lines 33-40);
 - b. Storing a content package in memory (col 10, lines 39-63 and col 15, lines 26-28);
 - c. The content package including a message, bank id, and display value (col 10, lines 39-63);
 - d. Instructions for receiving the value (col 11, lines 45-58);
 - e. Verifying the bank account id and the funds therein (col 7, lines 48-51);
 - f. Receiving notice of receipt of the package (col 5, line 54 – col 6, line 2);
- and
- g. Crediting the value to the receiver (user)(col 16, lines 13-17)

While Goldhaber does not explicitly disclose that the user will preset a desired value level for the display value and that the computer program will only display messages with values which meet or exceed that level, it is disclosed that the user presets a number of criteria for the selection of which messages will be selected and displayed when the user is registering with the system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to also set a minimum limit on the value of the message the user is willing to accept. One would have been motivated to have the user in Goldhaber set such a

Art Unit: 3622

minimum value level in order to increase the worth of Goldhaber's invention to the user by eliminating low value messages, thus increasing the user's satisfaction with the system.

Claims 3, 4, 14, 18, 38, and 42: Goldhaber discloses the method and apparatus of Claims 1, 13, 30, and 40 above, and further discloses paying the display value to the user upon the message (advertisement) being displayed to or interacted upon by the user. However, it is not explicitly disclosed that the user could receive additional payments for both displaying and interacting with the message, such as printing or playing the message. The Examiner notes that the disclosed interacting with the message by the user would encompass all types of interactions to include viewing, clicking on, printing, playing, listening to, or downloading and storing the message. These are all well known types of interactions between a user and information being displayed on the user's computer. It is also well known for an advertiser to pay a first amount when a user is initially displayed an advertisement, and then pay a second amount if the user interacts with the advertisement in one of the above mentioned ways. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer a first value to the user in Goldhaber upon initially displaying the advertisement and then a second value when the user interacts therewith, such as printing or playing the advertisement. One would have been motivated to pay an additional value to the user in view of Goldhaber's goals of enticing the user to accept advertisements and of tracking the user's interactions therewith.

Claims 15, 25, 26, 47, and 48: Goldhaber discloses the apparatus and computer program as in Claims 13, 22, and 40 above, and further discloses sending a notification upon completion of the funds transfer (col 17, lines 44-63).

Claims 16, 17, 34, and 46: Goldhaber discloses the method and computer program as in Claims 13, 30, and 40 above, and further discloses the message is displayed to or interacted upon by the user. However, it is not explicitly disclosed that the user interaction includes printing or playing the message. The Examiner notes that the disclosed interacting with the message by the user would encompass all types of interactions to include viewing, clicking on, printing, playing, listening to, or downloading and storing the message. These are all well known types of interactions between a user and information being displayed on the user's computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to print or play the message. One would have been motivated to include printing or playing the message as part of Goldhaber's interactions in order to provide a more memorable experience for the user; thus, increasing the likelihood that the user will remember the message (advertisement) and, in case of message being in the form of a coupon as Goldhaber discloses, providing a hard copy of the coupon for the customary in-store redemption.

Claims 19, 32, and 33: Goldhaber discloses the method and coupon program as in Claims 13 and 30 above, and further discloses providing the bank id (and account number) of the receiver (user)(col 16, line 13-17).

Claims 20 and 21: Goldhaber discloses the coupon program as in Claim 13 above, and further discloses the computer program running on various user devices to include a personal computer. While it is not explicitly disclosed that the computer program is running on a printer, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the user device could include a printer, if the printer had the required computing capability, or if a computer has a built-in printing capability. The Examiner notes that the line between a computer with printing capabilities and a printer with computing capabilities is very fine and is quickly becoming non-existent with the emergency of multiple-use devices. Thus, Goldhaber's disclosure of various types of user devices would also encompass a printer with the necessary processing and memory capabilities or a computer with the necessary printing capabilities.

Claim 23: Goldhaber discloses the apparatus as in Claim 22 above, and further discloses deleting the message if the value is too low (col 18, lines 49-50 and col 19, lines 4-18). Goldhaber discloses the system deactivating the advertisement once the user has accessed (and received payment for) it and also the user deleting the message when it is no longer desired. Therefore, it would have been obvious to one

Art Unit: 3622

having ordinary skill in the art at the time the invention was made for the system to delete messages that did not meet the user's criteria from the list of messages selected for delivery to the user. One would have been motivated to delete the messages that did not meet the user's minimum value level, in order to present only those messages that meet all of the user's selection criteria.

Claims 27-29: Goldhaber discloses the apparatus as in Claim 22 above, and further discloses that the value is monetary, a credit on a purchase, or a credit clip (i.e. coupon)(col 11, lines 8-44 and col 18, lines 13-33).

Claim 41: Goldhaber discloses the method as in Claim 40 above, and further discloses the message is an advertisement (col 9, lines 62-67 and col 15, lines 25-27).

Claim 44: Goldhaber discloses the method of Claim 40 above, and further discloses digitally signing the content package (col 10, lines 9-38 and col 16, lines 50-64).

8. Claims 2 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (5,794,210) in view of Dedrick(5,768,521).

Claims 2 and 31: Goldhaber discloses the method and apparatus of Claims 1 and 30 above, but does not explicitly disclose that the message has a message identifier (e.g. name, number, code, etc.). However, Dedrick discloses a similar

Art Unit: 3622

apparatus for presenting content packages to a user, which also discloses identifying the message in the content package with a unique identifier (col 3, lines 39-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also uniquely identify the message in Goldhaber. One would have been motivated to include a message identifier in order to allow Goldhaber to correlate the message with the correct content provider when determining which content provider account to debit.

Response to Arguments

9. Applicant's arguments with respect to claims 1-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

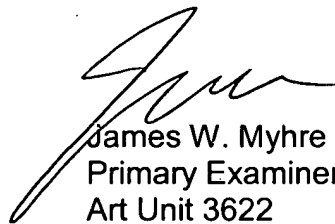
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM
April 22, 2005



James W. Myhre
Primary Examiner
Art Unit 3622